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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group: 6871 } Certificate Under 37 C.F.R. § 1.8(a)

Atty. Docket: HIS-P001 } I hereby certify that this correspondence is being

Applicants: Price et al. } deposited with the United States Postal Service as first

Invention: WASTE PROCESSING } class mail in an envelope addressed to the Commissioner

SYSTEM AND METHOD } for Patents, P. O. Box 1450, Alexandria, VA 22313-

Serial No.: 09/900,989 } 1450.

Filed: July 9, 2001 } on September 22, 2005

Examiner: Reagan, James A. }

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

Review is requested for the reasons stated on the attached five (5) sheets.

REASONS FOR REVIEW

In an illustrated embodiment of the present invention shown in Fig. 1, a waste management system 10 includes a service provider 11 arranging service between waste producing entities 20, 30, and vendors 40, 60, 80. Waste producing entities 20, 30 each produce one or more waste components. For example, entity 20 may produce a hazardous waste as a first waste component, and a recyclable plastic as a second waste component. Waste management vendors 40, 60, 80 are separate entities, each with the capability to manage a portion of the waste components produced by waste producing entities 20, 30. For example, vendor 40 may have the capability to manage hazardous waste produced by entity 20, and vendor 60 may have the capability to manage recyclable plastics produced by entity 20. The set of vendors 40, 60, and 80 form a waste service network.

The system 10 of the present invention is illustratively configured to collect vendor waste management data 110 for each vendor 40, 60 80. Illustratively, vendor waste management data 110 includes information regarding a vendor's capability to process or dispose of various types of waste components (e.g., hazardous waste, industrial waste, refuse, recyclable plastics, recyclable cardboard, etc.), and costs associated with such processing. The system is also configured to create and store entity profile data 120 for each entity 20, 30. Entity profile data 120 illustratively includes what waste components are produced by each entity, the manner in which each waste component is produced, the volume of each waste component produced, and how the waste components are stored. Entity profile data also includes processing costs associated with each waste component produced.

The Examiner rejected claims 22-48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,097,995 to Tipton combined with U.S. Patent No. 6,052,122 to Sutcliffe. Applicants respectfully traverse the Examiner's rejections.

For the U.S. Patent and Trademark Office to "establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." Manual of Patent Examining Procedure (MPEP) Section 2143. The Examiner's rejections fail to meet these criteria.

Tipton relates to a hazardous materials and waste reduction management system. Tipton discloses a system for allowing a user to manage chemicals from a central station. The system also allows for the tracking of individual chemical containers throughout the container's life. While Tipton does define "waste" as "a group of chemical containers classified as chemical stock waiting to be disposed of and removed from the inventory system", Tipton does not disclose or suggest how the waste is managed, processed or disposed. Therefore, Tipton does not disclose storing data associated with a plurality of waste management vendors providing waste management services to create a service network of vendors.

Sutcliffe relates to a method and apparatus for matching registered profiles. Sutcliffe is an on-line computer dating service for matching or introducing a first person to a second person having similar interests. Sutcliffe has nothing whatsoever to do with waste management.

1. THE PROPER TEST FOR MOTIVATION TO COMBINE REFERENCES

It is well known that when combining the content of various references "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Raynes*, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Federal Circuit has emphasized the requirement that the prior art must suggest the modifications necessary to achieve the claimed invention. The "mere possibility" that a prior art reference could be modified such that its use would lead to the particular result recited in a claim does not make that recited in the claim obvious "unless the prior art suggested the desirability of such a modification." *In re Ochia*, 71 F.3d 1565, 1570, 37 USPQ2d 1127 (Fed. Cir. 1995). "Obviousness cannot be established by hindsight combination to produce the claimed invention." *In re Dance*, 48 USPQ2d at 1637; *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re Dembiczak*, 50 USPQ2d at 1617; *Feil*, 227 USPQ at 547 (Fed. Cir. 1985). The prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); M.P.E.P. § 2141.02.

2. "A GREAT DEAL OF HINDSIGHT, IF ANY AT ALL" ISN'T THE PROPER TEST

The Examiner admits that Tipton does not disclose a matching mechanism within a database structure. See p. 6 of the Final Rejection. After this admission, the Examiner then merely states that it would have been obvious to combine Tipton and Sutcliffe. The Examiner does not point to any teaching in Tipton or Sutcliffe of any motivation to combine the two references to produce the claimed invention, because there is no such disclosure or suggestion in either reference. In discussing his combination of Tipton with Sutcliffe, the examiner stated:

"Clearly, one of ordinary skill in the art would not require a great deal of hindsight, if any at all, to suppose that a matching system applied to chemical waste management and a matching system used for dating purposes would find use in solving the problem of matching waste products with waste management services. " See Final Rejection, page 3. (emphasis added)

This statement alone should cause the Examiner's rejections to be reversed. Applicants submit that there is no disclosure or suggestion in Tipton or Sutcliffe of any motivation to combine these references to produce the claimed invention. Therefore such combination by the examiner uses impermissible hindsight and is therefore improper.

3. THE EXAMINER USES "NON-FUNCTIONAL DATA" ARGUMENT TO IGNORE CLAIM LIMITATIONS

The examiner has provided a lengthy statement on pages 2 and 3 of the Final Rejection related to non-functional data. Section 2106 VI of the MPEP states, in part:

Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

Clearly, the present claims include functional descriptive material. In connection with the independent system claims 22 and 43, Applicants submit that the claimed software and hardware disclosed in the block diagrams and flow charts provide supporting structure for the claim limitations which alter the performance of a standard computer system. For method claim 39, the limitations recited clearly effect how the process steps are performed to achieve the utility of the invention. See MPEP 2106 VI referenced above. Accordingly, the Examiner has improperly used the "non-functional data" argument to ignore proper claim limitations.

As set forth in the Amendment mailed March 25, 2005, even if Tipton and Sutcliffe are improperly combined using hindsight, this improper combination does not disclose or suggest the combination of elements recited in independent claims 22, 39 or 43. The examiner just refers to Tipton in broad generalities and does not address any of the specifically recited claim elements in these independent claims.

Specifically, the examiner does not point out any disclosure or suggestion in Tipton or Sutcliffe of at least the following elements from independent claim 22: a computer storage medium storing "waste management data associated with a plurality of vendors having waste management capabilities and providing waste management services and entity profile data associated with a plurality of waste producing entities having waste processing requirements and producing waste components" or first computer system "configured to access the computer storage medium and stored waste management data and entity profile data, and further configured to associate a set of vendors from the plurality of vendors to provide waste management service for the waste producing entity".

The examiner does not point out any disclosure or suggestion in Tipton or Sutcliffe of at least the following elements from independent claim 39: "creating a service network including a plurality of waste processing vendors"; "evaluating the waste processing capabilities of each of the waste processing vendors in the service network"; "receiving a waste processing service request from a waste producing entity"; "comparing the waste processing service request to the capabilities of the waste processing vendors in the service network"; and "selecting a vendor from the service network to fulfill the waste processing service request".

Finally, the examiner does not point out any disclosure or suggestion in Tipton or Sutcliffe of at least the following elements from independent claim 43: a computer storage medium storing "waste management entity profile data associated with a plurality of waste

producing entities having waste processing requirements and producing waste components"; and a first computer system "configured to access the computer storage medium and entity profile data, and further configured to associate a set of items for each of the plurality of waste producing entities, wherein each of the items is associated with the entity profile data".

4. THE EXAMINER'S OFFICIAL NOTICE IS OVER-REACHING

With regard to his rejections of certain defendant claims, the examiner took Official Notice that: "practices which reduce waste products while increasing profitability by reducing cost are old and well-known factors in matching consumer with vendor" and that "it is old and well known in the waste management [sic] that waste commonly consists of hazardous waste, industrial waste, refuse, recyclable plastics, and recyclable cardboard, among other things".

MPEP Section 2144.03 states:

While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

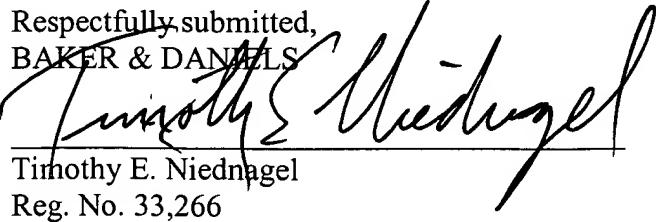
It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Applicants submit that the Examiner has used official notice to again avoid having to find claim limitations in the prior art. Applicants traverse the Examiner's use of Official Notice in this manner and requests supporting evidence from the examiner.

5. SUMMARY

For at least these reasons, applicants submit that independent claims 22, 39 and 43 as well dependent claims 23-38, 40-42 and 44-54 are in condition for allowance. Such action is respectfully requested.

Respectfully submitted,
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